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| 10/541,125 | 04/10/2006 | Alberto Turrini | 58009-019800/US | 6178 |

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| EXAMINER |
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LEWIS, KIM M

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| ART UNIT | PAPER NUMBER |
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3772

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12/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/541,125 | Applicant(s) TURRINI ET AL. | |
| | Examiner Kim M. Lewis | Art Unit 3772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTON

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56.

Response to Amendment

3. The preliminary amendments filed on 6/30/05 and 9/19/05 have been received and made of record. As requested, the specification and claims 1-11 have been amended

Specification

4. The disclosure is objected to because of the following informalities: Page 4, line 7, "and electrical" should read --an electrical--.

Appropriate correction is required.

Claim Interpretation

5. With respect to claim 1, applicant should note that the means statement invokes 112, 6th paragraph.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, claim 2 recites "the power-driving means comprises of a shaped pinion which is a part of a unit kinematically connected to an electrical type motor and to **a reduction gear unit**. The examiner is unclear as to what constitutes the reduction gear unit. Specifically, it is unclear if it is a part of the motor or a separate device and if it actually comprises gears.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4-7 and 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As regards claim 4, "the joint discs" lacks

proper antecedent basis. In claim 6, "the drive" lacks proper antecedent basis. In claims 5 and 13, it is unclear to the examiner if the language subsequent to "for example" and "more specifically" is a part of the claim. In claim 6, "the reduction unit" lacks proper antecedent basis. In claims 7 and 15, "the kinematic movement transmission organs" lacks proper antecedent basis. As to claims 9 and 14, "or another similar shape" is indefinite in that it does not positively define the shape of the clip. As to claim 11, after "wherein" a particular structural feature of the claim is missing and is therefore incomplete. Also, in claims 10-12, it is unclear if "the PLC control unit or the like, which acts by keyboard" is a part of the claim since the claims recite "if necessary".

10. Since the examiner can not properly ascertain, which features are present in the rejected claims, the claims that are unclear and indefinite, and the claims depending therefrom (e.g. claim 8, which is objected to) will not be given prior art comparisons until clarification is given.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,872,187 ("Stark et al.").

13. As regards claim 1, Stark et al. disclose orthoses for joint rehabilitation that anticipates applicants' invention. More specifically, Stark et al. disclose an articulated joint (orthosis 100) capable of use with a post-operative knee, comprising an articulated joint connected between a pair of uprights (140, 144 and 120, 122) each of which can be applied to two sectors of a body joint to be treated and a power-driving means (controller 232) for the angular movement of one upright with respect of the other, the power-driving means being fitted at a hinge point connected the two uprights (note the Abstract).

14. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,611,764 ("Bonutti et al.").

15. As regards claim 1, Bonutti et al. disclose an articulated joint (orthosis 100) capable of use with a post-operative knee, comprising an articulated joint connected between a pair of uprights each of which can be applied to two sectors of a body joint to be treated and a power-driving means (electric motor 150) for the angular movement of one upright with respect of the other, the power-driving means being fitted at a hinge point connected the two uprights (note Figs. 1 and 6, col. 3, line 55-col. 4, line 65 and col. 9, line 16-col. 10, line 5).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnutti or Hammersly.

20. As regards claims 2-4 and 10 the claims do not contain any features which, in combination with the features of any claim to which they refer, meet the novelty requirements. More specifically, the shaped pinion, reduction gear unit, a toothed pulley which engages a worm screw driven by a shaft of the motor, the location of the worm screw with respect to the pulley and a container/housing are well known features (see the cited references). Thus, it would have been obvious to one having ordinary skill in the art to modify Bonnuti or Hammersly with the claimed features to achieve the intended function.

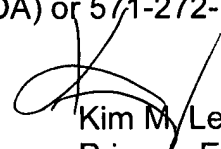
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kim M. Lewis
Primary Examiner
Art Unit 3772

kml
December 26, 2007